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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/541,372	07/05/2005	Arnold Keller	246472008200	1076
25227 7590 03/18/2008 MORRISON & FOERSTER LLP 1650 TYSONS BOULEVARD SUITE 400 MCLEAN, VA 22102				
EXAMINER				
SCHILLINGER, ANN M				
ART UNIT		PAPER NUMBER		
3774				
MAIL DATE		DELIVERY MODE		
03/18/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/541,372

**Applicant(s)**

KELLER, ARNOLD

**Examiner**

ANN SCHILLINGER

**Art Unit**

3774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5 and 7-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuoni (U.S. Pat. No. 5,593,446) in view of Andriacchi et al. (U.S. Pat. No. 4,279,042). Kuoni discloses the shaft with a tapering core cross-section (see Figure 2); longitudinal ribs (6) on the lateral and medians sides of a ribbed portion (any one section of the ribs located on the shaft) of the shaft whose height continuously increases from a proximal start of a ribbed portion to a distal end of the ribbed portion (see Figure 1); and the boundary of the shaft core cross-section between the two ribs located on the lateral does not protrude further laterally from the prosthesis than two ribs located on the lateral edges (see Figure 2). Kuoni does not disclose a substantially rectangular shaft core cross-section and the particular measurements as claimed by the Applicant. Andriacchi et al. teaches a rectangular cross-section with a ratio greater than 1:4 in Figures 3 and 4 and in col. 3, lines 29-42, which indicate that the shape and dimensions of the prosthesis may be altered to best suit the particular patient who will be receiving the prosthesis. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to adjust the shape and dimensions of the prosthesis to best suit a particular femur and allow the prosthesis optimal function.

Regarding the claim language discussing the axis ratio, It would have been obvious to one having ordinary skill in the art at the time the invention was made to use these values, since it has held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kuoni in view of Andriacchi et al., in further view of Blanquaert (U.S. Pat. No. 4,495,664). Kuoni, as modified by Andriacchi et al., discloses the invention substantially as claimed, however, they do not disclose the ribs having roughened surfaces. Blanquaert teaches a hip prosthesis with roughened ribs in col. 2, lines 3-13 for the purpose of promoting bone regrowth. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made, to have roughened surfaces on the ribs in order to promote bone regrowth.

#### ***Response to Arguments***

Applicant's arguments filed 12/10/2007 have been fully considered but they are not persuasive. As described above, the Kuoni reference has been re-interpreted so that only one section of the ribs along the shaft is being viewed. When viewing only one section as the ribbed portion, the height of the rib continuously increases from a proximal start of the ribbed portion of the shaft to a distal end of the ribbed portion of the shaft.

The term lateral is being interpreted from its dictionary definition which is "Of, relating to, or situated at or on the side" (lateral. Dictionary.com. *The American Heritage® Dictionary of the English Language, Fourth Edition*. Houghton Mifflin Company, 2004. <http://dictionary.reference.com/browse/lateral> (accessed: March 10, 2008)). The Kuoni reference

meets this limitation as the ribs are located on the outside of the shaft. The rectangular shape of the shaft is taught by Andriacchi et al., as described above and in the previous office action.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANN SCHILLINGER whose telephone number is (571)272-6652. The examiner can normally be reached on Mon. thru Fri. 9 a.m. to 4 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ann Schillinger/  
Examiner, Art Unit 3774

/Corrine M McDermott/  
Supervisory Patent Examiner, Art Unit 3738